

REMARKS

Status of Claims

Claims 1-19 are pending, of which claim 1 is independent. Claims 1 and 15-18 have been amended to correct informalities in the claim language and to more clearly define the claimed subject matter. Claim 19 has been added. Care has been taken to avoid introducing new matter. For the reasons set forth below, Applicants respectfully submit that all pending claims as currently amended are patentable over the cited prior art.

Claim Objections

Claim 15 was objected to because of minor informalities. Applicants respectfully submit that the amendment made to claim 15 overcomes this objection. Therefore, Applicants respectfully request reconsideration and withdrawal of this objection.

Rejection under 35 U.S.C. § 102

Claims 1-4, 6-11 and 13-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mitchell et al. (USP 5,573,679). This rejection is traversed.

Applicants respectfully remind the Examiner that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Applicants respectfully submit that, at a minimum, Mitchell fails to disclose that “*a top portion, facing to the first electrode, of the air gap is in contact with the first insulating film,*” and “*a bottom portion, facing to the second electrode, of the air gap is in contact with the second insulating film,*” as recited by amended claim 1. With these features of claim 1, the sticking between the first electrode and the second electrode can be prevented.

In contrast, in Mitchell, the alleged insulating films (28, 26 or 20, 14) are not formed so as to be in contact with a top portion (facing the alleged first electrode) of the alleged air gap 30, and the electrode 22 comes into contact with the air gap 30. As such, it is clear that Mitchell fails to disclose the above identified features of amended claim 1 within the meaning of 35 U.S.C. § 102. Accordingly, claim 1 and all claims dependent thereon are patentable over the cited reference.

Regarding claims 3 and 4, Applicants respectfully submit that Mitchell fails to disclose that the first insulating film and the second insulating film, which are in contact with the top and bottom of the air gap, respectively, are insulating films having tensile stress or made of silicon nitride. The Examiner asserts that dielectric films 20 and 14 of Mitchell are made of silicon nitride having a tensile stress. However, films 20 and 14 are not in contact with the air gap. Accordingly, films 20 and 14 do not correspond to the claimed first and second insulating film, respectively. As such, it is clear that Mitchell fails to disclose the subject matter of claims 3 and 4 within the meaning of 35 U.S.C. § 102. Thus, claims 3 and 4 are patentable over Mitchell on their own merit in addition to the dependency upon claim 1.

Regarding claim 7, Applicants respectfully submit that the alleged FIGS. 2B-2D of Mitchell do not disclose the subject matter of claim 7 within the meaning of 35 U.S.C. § 102. The Examiner, citing FIGS. 2B, 2C, and 2D of Mitchell, asserts that Mitchell discloses the

subject matter of claim 7. However, FIGS. 2B, 2C, and 2D of Mitchell illustrate a part of the steps for fabricating the device, not an MEMS device in a complete state. Further, since claim 7 depends upon claim 1 which recites an air gap, it is clear that FIGS. 2B, 2C, and 2D fail to disclose the claimed air gap as required by claim 7. As such, it is clear that Mitchell fails to disclose or suggest the structure of claim 7. Thus, claim 7 is patentable over Mitchell on its own merit in addition to the dependency upon claim 1.

Based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-4, 6-11 and 13-17 under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103

Claims 5, 12 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell. This rejection is respectfully traversed for at least the following reasons.

Applicants incorporate herein the arguments previously advanced in traversal of the rejection under 35 U.S.C. § 102(b) predicated upon Mitchell. Dependent claims 5, 12 and 18 are free from the applied art in view of their dependency from independent claim 1. Thus, Applicant respectfully requests that the Examiner withdraw the rejection of claims 5, 12 and 18 under 35 U.S.C. § 103(a).

New Claims

Since new claim 19 depends upon claim 1, this claim is also patentable over Mitchell for at least the same reasons as claim 1. Also, since Mitchell fails to disclose the features of claim 19, this claim is patentable for its own merit in addition to the dependency upon claim 1.

Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Takashi Saito
Limited Recognition No. L0123

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 TS:MaM
Facsimile: 202.756.8087
Date: February 19, 2010

**Please recognize our Customer No. 53080
as our correspondence address.**